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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,476	10/08/2003	Ron Hyman Rothman	10-366-US (cbs020000)	7476

98804 7590 09/29/2010

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EXAMINER	
FABER, DAVID	

ART UNIT	PAPER NUMBER
2178	

NOTIFICATION DATE	DELIVERY MODE
09/29/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/681,476	ROTHMAN ET AL.	
	Examiner	Art Unit	
	DAVID FABER	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 September 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,5-10,13-20,22-27,29-36,39-44 and 47-65* is/are pending in the application.

4a) Of the above claim(s) *65* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,5-10,13-20,22-27,29-36,39-44 and 47-64* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to the amendment filed on 7 September 2010.

This office action has been made Final.

2. Claims 1, 5, 9, 13, 17-19, 22, 26, 29, 33-35, 39, 43, 47, 51-52 have been amended.

3. Claim 65 has been added.

4. Claims 1, 2, 5-10, 13-20, 22-27, 29-36, 39-44, and 47-64 are pending. Claims 1, 9, 17, 18, 19, 26, 33, 34, 35, 43, 51, and 52 are independent claims.

Election/Restrictions

5. Newly submitted claim 65 is directed to an invention that is independent or distinct from the invention originally claim for the following reasons: Claim 65, although includes creating a creative, from a programmable creative definition, that includes proprietary information from a private database, wherein Claim 65 only claims creating a creative with proprietary information from a private database, and also claim after a predetermined time, a second creative is created through a programmable creative definition by retrieving an update to the proprietary information from the private database and using the updated proprietary information to create the second creative. Therefore, said clam is directed to authoring diverse media presentation, class 715, subclass 202

In contrast, all other pending claims are substantially directed to the creation of a creative using information from multiple databases and using a scheduler to transmit the created creative, class 715, subclass 201.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 65 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections – 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1,2, 5, 9-10, 13, 17-20, 22, 26-27, 29, 33-36, 39, 43-44, 47, and 51-64 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman et al (US Patent 6,317,761, published 11/13/2001) in further view of Shaw et al (US PGPub 2001/0005855, published 6/28/2001) in further view of Heene et al (US PG Pub 2004/0254853, filed 6/10/2004, provisional filed on 6/12/2003)

As per independent claim 1, Landsman et al discloses a system/method comprising:

- receiving a creative definition; the creative definition being associated with a creative that is selectable by the advertising system (Column 3, lines 23-61; Column 17, lines 37-52)
- determining if the creative definition is a programmable or non-programmable creative definition; (Column 3, lines 45-61; Column 17, lines 37-52: Browser has the ability to determine if the embedded code is a banner or is a javascript program)
- assembling a non-programmable creative if the creative definition is a non-programmable creative definition; and (Column 3, lines 45-61: Discloses obtaining the graphic to be rendered)
- executing the programmable creative definition to generate the creative, if the creative definition is a programmable creative definition, the programmable creative definition to generate the creative; storing the creative; (Column 17, lines 37- Col 20, line 17: Discloses reading the advertising tag and executing the JavaScript code associated with the advertisement wherein the advertisement is stored at the server,)

However, Landsman et al fails to disclose performing the limitations on the server-side system. On the other hand, Landsman discloses a client/server architecture in a networked environment (Col 15, lines 48-51) wherein the server can be a separate software application which executes on any computer in the networked environment. (Column 15, lines 61-64) Therefore, It was well-known to one of ordinary skilled in the art at the time of Applicant's invention that the functionality of a client/server architecture

is applicable and interchangeable between a client and a server since there is no real significant differences between the processing abilities of a client and a server. In addition, one of ordinary skill in the art would not see any reason why certain data processing techniques, once taught, cannot or should not be applied to either the client or server side of a system. Each side contains a data processing unit and techniques for one processing unit may very well be applicable to other data processing units; therefore, a program tailored to be executed on a client can also be executed on a server.

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modified Landsman's method to perform on a server since it would have provided the benefit of taking advantage of server capabilities of management and distribution duties with other clients that a server provides to a client.

Furthermore, Landsman et al discloses wherein the step of executing the programmable creative definition to generate the creative includes the step of retrieving, responsive to the programmable creative definition, proprietary information from the server-side system. (Col 16, line 53 – Col 17, line 21, Column 21, lines 46-60: Discloses data (AdDescriptor file) capable of being streamed proprietary, thus the information is viewed as being proprietary information) and non-proprietary information from the server side system, including at least a portion of non-proprietary information in the creative (Col 3, lines 54-57; Claim 2: Discloses the banner includes a file that is stored on the server that makes up at least a portion of the banner.) however, fails to specifically disclose as a function of scheduling by the advertising system and in

response to a request from the client-side system: selecting the stored creative by the advertising system for transmission.

On the other hand, Shaw et al discloses scheduling by the advertising system and in response to a request from the client-side system: selecting the stored creative by the advertising system for transmission, and transmitting the selected creative through the electronic network from the publisher on a server-side system via the web server to the viewer on the client-side system. (0033-0034, 0048-0049, 0098, 0146, 00157: Discloses when the client makes a connection to the server system (a form of a request), eligible advertisements are transmitted to the client from the server wherein the eligible ads are determined based on scheduling information in which a scheduler decides which ads are eligible for distribution for each user (client) and when to distribute the ads.)

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified Landsman's method with Shaw et al's method since Shaw et al's method would have provided the benefit of effectively transmitting the right advertisements targeted to the correct users during the correct times without substantially expending unnecessary resources.

Furthermore, Landsman discloses including non-proprietary information in the creative (Col 3, lines 54-57; Claim 2) and Shaw et al discloses banner advertisements are in a proprietary format (The format is a part of the creative thus proprietary data is in the creative) (Paragraph 0098-0099) However, Landman and Shaw fail to specifically disclose proprietary information from a private database in the server-side system and

including at least a portion of the proprietary and non-proprietary information in the creative. However, Heene et al discloses a periodical publisher creating e-commence enabled online classified advertisements based on print classified counterparts and other information stored in multiple databases associated with the one or more Web servers. One of the databases used is an associated print classified ad database containing ad data used printed advertisements.(print classified counterparts) This data is proprietary to the publisher and the data is private to the publisher. Furthermore, an online classified ad is created that includes using the printed classified ad stored in the print classified ad database and advertisement data (other information) from an ad placement software database wherein an online ad data formatting module receives ad data, process the data by formatting the collected data into an online classified. (Paragraph 0048, 0068-0069, 0081, 0084) Thus, the proprietary data and advertisement data/other information (i.e. non-proprietary data) is used into the newly created online classified ad.

It will have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified Landsman's method and Shaw's method with Heene et al's method since Heene et al would have provided the benefit of providing the same content as in print by taking advantage of online ad enhancement and transactions capabilities

As per dependent claim 2, Landsman et al discloses wherein the executing further includes periodically executing the programmable creative definition responsive

to a request generated by the advertising system. (Col 17, lines 7-21, Column 18, lines 38-49: Discloses the advertising system generating a request to download the advertisement based on the URL provided, wherein an applet is then executed to download the advertisement)

As per dependent claim 5, Claim 5 recites similar limitations as in Claim 1, and is similarly rejected under rationale. However, based on the rejection of Claim 1, and the rationale incorporated, Shaw et al discloses the advertisement being transmitted to the server for transmitting the advertisement to the client (FIG 6; Paragraph 0146, 0181)

As per independent claim 9, Claim 9 recites similar limitations as in Claim 1 and is rejected under similar rationale. Furthermore, Landsman et al discloses a processor and memory. (Column 39, lines 39-45)

As per dependent claim 10, Claim 10 recites similar limitations as in Claim 2 and is rejected under similar rationale.

As per dependent claim 13, Claim 13 recites similar limitations as in Claim 5 and is rejected under similar rationale.

As per independent claim 17, Claim 17 recites similar limitations as in Claim 1 and is rejected under similar rationale.

As per independent claim 18, Claim 18 recites similar limitations as in Claim 1 and is rejected under similar rationale.

As per independent claim 19, Claim 19 recites similar limitations as in Claim 1 and is similarly rejected under rationale. Furthermore, Landsman et al discloses a method compromising:

- storing a first definition for a non-programmable creative; the first definition being associated with a creative that is selectable by the advertising system (Column 3, lines 23-61: Discloses embedding HTML code in a web page to generate a banner)
- storing a second definition for a programmable creative including a program for generating the programmable creative; the second definition being associated with a creative that is selectable by the advertising system (Column 17, lines 37-58: Discloses embedding a special HTML advertising tag that contains a URL to a Javascript program)
- executing the first definition to generate a non-programmable creative; storing the non-programmable creative; (Column 3, lines 45-61: When the HTML code is interpreted by the client's browser, it fetches and downloads the banner to the client's browser to be rendered to the client. The banner is stored on a server and in the client's browser when retrieved)
- executing the second definition to generate a programmable creative; storing the programmable creative (Column 17, lines 37- Col 20, line 17: Discloses reading the advertising tag and executing the JavaScript code associated with the advertisement, wherein the advertisement is stored at the server, or at the client's browser)

As per dependent claim 20, Landsman et al discloses executing the second definition to generate a programmable creative includes periodically executing the

second definition to generate an updated programmable creative. (Col 20, lines 24-28; 40-49; 15-42)

As per dependent claim 22, Claim 22 recites similar limitations as in Claim 5 and is rejected under similar rationale.

As per independent claim 26, Claim 26 recites similar limitations as in Claim 19 and is rejected under similar rationale. Furthermore, Landsman et al discloses a processor and memory. (Column 39, lines 39-45)

As per dependent claim 27, Claim 27 recites similar limitations as in Claim 20 and is rejected under similar rationale.

As per dependent claim 29, Claim 29 recites similar limitations as in Claim 5 and is rejected under similar rationale.

As per independent claim 33, Claim 33 recites similar limitations as in Claim 19 and is rejected under similar rationale.

As per independent claim 34, Claim 34 recites similar limitations as in Claim 19 and is rejected under similar rationale.

As per independent claim 35, Claim 35 recites similar limitations as in Claim 1 and is rejected under similar rationale.

As per dependent claim 36, Claim 36 recites similar limitations as in Claim 2 and is rejected under similar rationale.

As per dependent claim 37, Claim 37 recites similar limitations as in Claim 3 and is rejected under similar rationale.

As per dependent claim 38, Claim 38 recites similar limitations as in Claim 4 and is rejected under similar rationale.

As per dependent claim 39, Claim 39 recites similar limitations as in Claim 5 and is rejected under similar rationale.

As per independent claim 43, Claim 43 recites similar limitations as in Claim 1 and is rejected under similar rationale.

As per dependent claim 44, Claim 44 recites similar limitations as in Claim 2 and is rejected under similar rationale.

As per dependent claim 45, Claim 45 recites similar limitations as in Claim 3 and is rejected under similar rationale.

As per dependent claim 46, Claim 46 recites similar limitations as in Claim 4 and is rejected under similar rationale.

As per dependent claim 47, Claim 47 recites similar limitations as in Claim 5 and is rejected under similar rationale.

As per independent claim 51, Claim 51 recites similar limitations as in Claim 1 and is rejected under similar rationale.

As per independent claim 52, Claim 52 recites similar limitations as in Claim 1 and is rejected under similar rationale.

As per dependent claim 53, based on the rejection of Claim 1 and the rationale incorporated, Heene et al discloses wherein the proprietary information provides text that is displayed by the creative. (Claim 7: text description of the item for sale)

As per dependent claims 54-64, Claims 54-64 recites similar limitations as in Claim 53 and is rejected under similar rationale.

8. Claims 6-8, 14-16, 23-25, 30-32, 40-42, and 48-50 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman et al (US Patent 6,317,761, published 11/13/2001) in further view of Shaw et al (US PGPub 2001/0005855, published 6/28/2001) in further view of Heene et al (US PG Pub 2004/0254853, filed 6/10/2004, provisional filed on 6/12/2003) in further view of Galomb (US PGPub 20010039510, published 11/8/2001)

As per dependent claims 6-8, Landsman et al discloses the ability for an advertiser to change or update any of its advertisements by just modifying appropriate media and AdDescriptor files that reside in the third-party advertising management system. (Column 13, lines 55-66) However, Landsman et al and Shaw et al fail to specifically disclose periodically changing text, an image, or a hyperlink within the creative. However, Galomb discloses advertisement includes text, images, and/or hyperlinks. (Paragraph 0004) Thus, in conjunction of Landsman et al and Wen with Galcomb, an advertiser would have the ability to change its advertisements by modifying the text, image or hyperlink associated with the advertisement.

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modify Landsman et al and Shaw et al with Galomb's advertising system to enable since it would have provided the benefit of the need for

advertisers to directly and instantly control the testing and optimizing of their advertisements.

As per dependent claims 14-16, Claims 14-16 recites similar limitations as in Claim 6-8 and is rejected under similar rationale.

As per dependent claims 23-25, Claims 23-25 recites similar limitations as in Claim 6-8 and is rejected under similar rationale.

As per dependent claims 30-32, Claims 30-32 recites similar limitations as in Claim 6-8 and is rejected under similar rationale.

As per dependent claims 40-42, Claims 40-42 recites similar limitations as in Claim 6-8 and is rejected under similar rationale.

As per dependent claims 48-50, Claims 48-50 recites similar limitations as in Claim 6-8 and is rejected under similar rationale.

Response to Arguments

9. Applicant's arguments filed 7 September 2010 have been fully considered but they are not persuasive.

10. On pages 21-22, in regards to the independent claims rejected under 103(a), Applicant argues that the applied references, primarily, Henne fails to teach a creative including proprietary from a server-side private database and non-proprietary information stored on the server-side. However, the Examiner disagrees.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Examiner respectfully submits that Landsman discloses including non-proprietary information in the creative (Col 3, lines 54-57; Claim 2: Discloses the banner includes a file that is stored on the server that makes up part of the banner) and Shaw et al discloses banner advertisements are in a proprietary format (The format is a part of the creative thus proprietary data is in the creative) (Paragraph 0098-0099) However, Landman and Shaw fail to specifically disclose proprietary information from a private database in the server-side system and including at least a portion of the proprietary and non-proprietary information in the creative. However, Heene et al discloses a periodical publisher creating e-commence enabled online classified advertisements based on print classified counterparts and other information stored in multiple databases associated with the one or more Web servers. One of the databases used is an associated print classified ad database containing ad data used printed advertisements.(print classified counterparts) This data is proprietary to the publisher and the data is private to the publisher. Furthermore, an online classified ad is created that includes using the printed classified ad stored in the print classified ad database and advertisement data (other information) from an ad placement software database wherein an online ad data formatting module receives ad data, process the data by formatting the collected data into an online classified. (Paragraph 0048, 0068-0069,

0081, 0084) Thus, the proprietary data and advertisement data/other information (i.e. non-proprietary data) is used into the newly created online classified ad.

It will have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified Landsman's method and Shaw's method with Heene et al's method since Heene et al would have provided the benefit of providing the same content as in print by taking advantage of online ad enhancement and transactions capabilities.

Conclusion

11. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Faber whose telephone number is 571-272-2751. The examiner can normally be reached Monday-Thursday, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Faber/
Examiner, Art Unit 2178

/William L. Bashore/

Supervisory Patent Examiner, Art Unit 2175